

REMARKS

This is in response to the Final Office Action mailed June 9, 2005, in which the Examiner withdrew claims 19 and 23 and rejected claims 1-18, 20-22, 24 and 25. Reconsideration of the application is respectfully requested.

Action Prematurely Made Final

Applicant disagrees with the Examiner's finding that Applicant's Amendment filed February 11, 2005 "necessitated the new ground(s) of rejection presented in this Office Action", since no substantive changes were made to the claims. Rather, the claim language used to describe the relative positions of the return and main poles was only modified based on a stylistic preference of the Examiner, presented during a telephone interview of February 3, 2005, in an effort to move the prosecution of this case along. Thus, there is no substantive difference between the manner in which Applicant previously described the relative positions of the main and return poles with reference to the moving magnetic medium and the amended form of independent claims 1, 10, 14 and 20, as explained in the Amendment filed February 11, 2005. Therefore, Applicant submits that the basis for making the present Office Action final is improper and, more importantly, unfair to Applicant.

Improper Withdrawal of Claim 23

In Section 1 of the Office Action, the Examiner withdrew claim 23 from prosecution as being drawn to a non-elected species. However, Applicant identified claim 23 in the response filed February 11, 2005, as reading on the elected species. Therefore, Applicant submits that the withdrawal of claim 23 from prosecution is improper and requests that claim 23 be admitted for prosecution. Applicant also submits that claim 23, which has not

been rejected, is in condition for allowance.

Request for Reconsideration of the Requirement

In Section 2 of the Office Action, the Examiner found Applicant's traversal of the election requirement mailed January 12, 2005 to be non-persuasive and made the requirement final. Applicant maintains that the election requirement is improper for the reasons set forth in the response mailed February 11, 2005, and requests reconsideration of the requirement.

Amendments

In Section 4 of the Office Action, the Examiner objected to the specification for an informality on page 5, line 10. With this amendment, Applicant has corrected the error and requests that the objection be withdrawn.

Also in Section 4 of the Office Action, the Examiner quoted a paragraph on page 15 of the application and another paragraph on page 5, and concluded that FIGS. 5 and 6 are "separate embodiments as disclosed by the specification and shown by the figures."

One purpose of the simplified diagram of FIG. 6 is to illustrate the different cross-sectional areas of the main and return pole tips, which cannot be determined from the side view of FIG. 5. In that respect, Applicant does not believe that there is an inconsistency in the description of FIGS. 5 and 6. Thus, the rationale for the objection is not apparent. Even so, Applicant has amended the description of FIG. 6 in an effort to satisfy the Examiner and move the prosecution of this case forward. Applicant requests that the objection be withdrawn.

In Section 5 of the Office Action, the Examiner objected to claims 7 and 8 for various informalities. With this amendment, Applicant has corrected the errors in claims 7 and 8 and requests that the objections be withdrawn.

Claim Rejections - 35 U.S.C. §102

In Section 6 of the Office Action, the Examiner rejected claims 1-3, 7-16, 20-22, 24 and 25 under 35 U.S.C. §102(e) as being anticipated by Lin (2003/0043513). Applicant respectfully disagrees with the Examiner's assessment of the cited reference.

Applicant disagrees with the Examiner's finding that "Lin shows in figure 3 and describe [sic] in section [0020] a head for use with a magnetic medium 17 moving in a first direction . . . . [that] includes a perpendicular writing element having a main pole 22 having a main pole tip 28 . . . . [a] return pole 23 . . . connected to the main pole 22 at a back gap 35 and having a return pole tip positioned from the main pole 22 in the first direction." The Examiner fails to identify where Lin identifies the cited "first direction". Applicant submits that Lin fails to describe the "first direction" in which the moving magnetic medium is traveling, from which the relative positions of the cited main and return poles can be determined. Accordingly, there is no basis from which to assert that the positions of the return and main poles of Lin relative to the moving magnetic medium is any different than that of the prior art, such as that described in the present application with reference to FIGS. 2 and 3.

Accordingly, Lin fails to teach or suggest "a head for use with a magnetic medium moving in a first direction . . . comprising . . . a perpendicular writing element including a main pole having a main pole tip, a return pole connected to the main pole at a back gap and having a return pole tip positioned from the main pole in the first direction", as described in claim 1; "a head for use with a magnetic medium moving in a first direction, the head comprising a perpendicular writing element including a main pole having a main pole tip, a return pole connected to the main pole at a back gap and having a return pole tip position from the main pole in the first direction", as described in claim 10;

"a head for recording perpendicularly oriented magnetic patterns to a magnetic medium moving in a first direction, the head comprising main and return poles separated by a write gap, the return pole positioned from the main pole in the first direction", as described in claim 14; or "a head for use with a magnetic medium moving in a first direction . . . comprising . . . a return pole having a return pole tip located in the first direction from the main pole", as described in claim 20.

Therefore, Applicant submits that independent claims 1, 10, 14 and 20 are not anticipated by Lin, and requests that the rejections be withdrawn. Additionally, Applicant submits that all claims depending from independent claims 1, 10, 14 and 20 are allowable as being dependent from allowable base claims, and requests that the rejections be withdrawn.

#### Claim Rejections - 35 U.S.C. §103

In Section 9 of the Office Action, the Examiner rejected claims 4-6 and 17-18 under 35 U.S.C. §103(a) as being unpatentable over Lin. Applicant submits that claims 4-6 and 17-18 are allowable for at least the reasons set forth above and does not concede the correctness of the Examiner's argument with regard to Lin. Therefore, Applicant requests that the rejections be withdrawn.

#### Conclusion

In light of the above comments and remarks, Applicant submits that the present application is in condition for allowance. Reconsideration and favorable action is respectfully requested.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

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